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Name of applicant, assignee or registered representative

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Signature

October 1, 2007
Date of Signature

PATENT
Case No.: AUS920010390US1
(9000/41)

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

In re patent application of:)	
)	
KULVIR S. BHOGAL, ET AL.)	Examiner: ZEWDU, M.
)	
Serial No.: 09/881,873)	Group Art Unit: 2617
)	
Filed: JUNE 14, 2001)	
)	
Title: TRACKING COMMUNICATIONS))	Conf. No.8232
USAGE TIME)	

REPLY BRIEF

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Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

Appellants herewith respectfully present their Reply Brief on Appeal as follows:

The Examiner continues to misconstrue the claims and misapply the law in this case.

With respect to the improper claim objections, Appellants note that the Examiner wholly ignores the utter lack of informality in any of claims 2-4 or 17-19 and has failed to justify the objection. These claims are not informal in any fashion, and the Examiner's 'argument' solely serves to obfuscate the issues in this case. The Examiner must consider the actual claim language (i.e., see the objection to claims 2 and 17 wherein the Examiner asserts that a claim reciting "adding" is informal despite those claims reciting "summing"). In essence, the Examiner is objecting to claims, not due to informality, but because the Examiner has not read the claims or understood the invention.

With respect to the anticipation rejections, at a minimum, Lahtinen does not disclose modifying the call count based on calling plan parameters as claimed in claims 1, 16, and 31. At most, Lahtinen discloses adding to a call counter. See, column 4, lines 3-17. No mention of calling plan parameters is included in the disclosures of Lahtinen.

In addition, Lahtinen does not disclose discounting an incoming call, as claimed in claims 6 and 21. At most, Lahtinen discloses adding call time, but not discounting any calls. See, column 4, lines 3-17. Withdrawal of the §102 rejections is requested.

To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art." *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). "All words in a claim must be considered in judging the patentability of that claim against the prior art." *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970).

With respect to claim 32, Lahtinen fails to teach or suggest modifying the call count based on calling plan parameters, as claimed. In addition, the Examiner does not rely on Toda for such a teaching, and therefore the §103(a) rejection fails on at least this ground. In addition, however, neither Lahtinen nor Toda discloses or teaches storing the modified call count in the memory of a cellular telephone unit, as claimed in claim 32. At most, Toda discloses a counter, but Toda does not disclose storing any data in the memory of a cellular telephone unit.

Next, as outlined above, Lahtinen does not disclose or teach discounting a call for any reason. Second, Toda does not disclose or teach discounting a call for any reason. Therefore, the references alone or in combination cannot teach or suggest discounting a nighttime call as claimed in claims 7 and 22 or discounting a weekend call as claimed in claims 8 and 23.

Furthermore, there can be no motivation to combine Lahtinen with Toda to store data in the memory of a cellular telephone unit, as claimed in claim 32. Lahtinen teaches that it is desirable to prevent mobile system overload while storing or updating location information relating to mobile stations in a VLR (col. 2, lines 11-14). Thus, Lahtinen is addressing problems at a base station that simply cannot be solved by storing data at the cellular phone level. In fact, storing such data at the cellular phone level would be harmful, according to Lahtinen, since the data could be lost if the phone is deactivated or leaves the service area. Therefore, combining the alleged teachings of Toda with Lahtinen would destroy the principle of operation of Lahtinen, in contravention of the strictures of §103(a).

Additionally, were the combination of references as 'obvious' as suggested by the Examiner those of skill in the art would have surely made the combination prior to the Appellants. This is especially true in a field as subject to rapid advancement and rapid innovation as the field of tracking communication time. As noted by the BPAI in *Ex Parte Catan*:

The person of ordinary skill in the art is a hypothetical person who is presumed to know the relevant prior art. *Custom Accessories, Inc. v. Jeffrey-Allan Indus., Inc.*, 807 F.2d 955, 962, 1 USPQ2d 1196, 1201 (Fed. Cir. 1986). In determining this skill level, the court may consider various factors including "type of problems encountered in the art; prior art solutions to those problems; rapidity with which innovations are made; sophistication of the technology; and educational level of active workers in the field." *Id.* (cited in *In re GPAC*, 57 F.3d 1573, 1579, 35 USPQ2d 1116, 1121 (Fed. Cir. 1995)). In a given case, every factor may not be present, and one or more factors may predominate. *Id.* at 962-63, 1 USPQ2d at 1201.

In a field as rapidly advancing as this, the time gap between the references and the instant filing *precludes* a finding of obviousness, since the combination would have been known given the rapidity of innovation, the sophistication of this technology and the exceptionally high educational level of active workers in the field. Thus, the Examiner's *ad hoc* combination herein is not simply a matter of substituting one element for another element, but instead is an example of impermissible hindsight. The Examiner has ignored the mandatory *Graham* factors, and ignored the need to consider the person of ordinary skill in the art.

Yet further, claims 7, 8, 22, and 23 depend from allowable claims 1 or 16 as outlined above, and are therefore allowable for at least the same reasons.

Withdrawal of the rejections to claims 7-8, 22-23, and 32 is requested.

The rejection of the remaining dependent claims as unpatentable over various references is traversed. Where an independent claim is nonobvious, any claim depending therefrom is also non-obvious. See MPEP 2143.03 (If an independent claim is non-obvious under 35 U.S.C. §103, then any claim depending therefrom is nonobvious. *In re Fine*, 837 F.2d 1071, 5 USPQ 1596 (Fed Cir. 1988)).

Withdrawal of the rejections to all claims is requested.

SUMMARY

The Appellants respectfully submit that claims 1-32 fully satisfy the requirements of 35 U.S.C. §§102, 103 and 112. In view of the foregoing, favorable consideration and early passage to issue of the present application is respectfully requested.

Dated: **October 1, 2007**

Respectfully submitted,
KULVIR S. BHOGAL, *et al.*

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